

REMARKS

Reconsideration of the application and the amendments above is respectfully requested. Claims 1-15 were pending in the present application. Claims 1-15 are rejected. Currently, Claims 1-15 are pending in the present application.

REJECTION UNDER 35 U.S.C. 102(a)
FOR LACK OF NOVELTY

The Examiner rejected Claims 1-15 under 35 USC 102(a) as being anticipated by Bednarek (WO 03/006604). The Examiner stated that the instant claims are drawn to a method of inhibiting alcohol consumption comprising administering a therapeutically effective amount of a selective melanocortin 4 receptor agonist of formula I to a subject in need thereof. The Examiner further stated that Bednarek (WO 03/006604) discloses selective agonists of the melanocortin 4 receptor of formula I that are useful for the treatment of disorders or diseases mediated through the melanocortin 4 receptor. The Examiner further stated that selected melanocortin 4 receptors are useful to inhibit alcohol consumption, therefore the cited reference is deemed to anticipate the instant claims.

Applicants respectfully disagree. Applicants submit that 35 U.S.C. 102(a) requires that an invention was known or used by others or described in a printed publication before the invention thereof by the applicant. Bednarek et al. does not disclose that the selective melanocortin 4 receptor agonists of formula I are useful to inhibit alcohol consumption. As a result, Bednarek et al. does not anticipate the instant method of treatment claims.

Applicants submit that Bednarek et al. discloses the following utilities for the compounds of formula I:

a) page 1, lines 31-33: compounds at the MC-4R might be useful in the treatment of eating disorders;

b) page 2, lines 1-3: melanocortin 4 receptor appears to play a role in other physiological functions as well, namely in controlling grooming behavior, erection and blood pressure;

c) page 2, lines 18-20: these compounds are useful as research tools for the determination of the physiological roles of the MC-4 receptor, as well as for the diagnosis, treatment or prevention of disorders or diseases mediated through the MC-4 receptor;

d) page 3, lines 16-21: compounds are useful as analytical research tools for the study of physiological roles of the melanocortin 4 receptor; additionally, the compounds are useful for the diagnosis, treatment and prevention of diseases and disorders that may benefit from the activation of the MC-4 receptor, particularly diseases and disorders related to eating disorders.

e) page 4, lines 27-30: the compounds of formula I are useful in the treatment, control or prevention of diseases, disorders or conditions responsive to the activation of the MC-4 receptor such as the prevention and treatment of obesity, as well as male and female sexual dysfunction; and

f) page 13, Claim 11: A method for the prevention or treatment of obesity in a human which comprises administering to said human a pharmacologically effective amount of a compound of Claim 1.

Applicants submit that Bednarek et al. did not disclose, teach or suggest that the compounds of formula I are useful to: a) inhibit alcohol consumption (present Claims 1-5 and 11-15); b) reduce alcohol consumption (Claims 6-8); c) treat alcoholism (Claim 9); or d) treat alcohol abuse (Claim 10).

Further, one of skill in the art would not be motivated to use the compounds of formula I to inhibit alcohol consumption, reduce alcohol consumption, treat alcoholism, or treat alcohol abuse based on the utilities disclosed in Bednarek et al.

Applicants also submit that the general statement in Bednarek et al. indicating that the compounds of formula I are useful for the treatment or prevention of disorders or diseases mediated through the MC-4 receptor does not anticipate a specific use for the compounds of formula I that is not disclosed in Bednarek et al. The claims of the present invention are method of treatment claims directed to treating disorders that were not specifically disclosed in Bednarek et al. As a result, the claims of the present invention are not anticipated by Bednarek et al.

In view of the above arguments, Applicants respectfully submit that Claims 1 – 15 are novel, and request reconsideration and withdrawal of the rejection of Claims 1-15 under 35 USC 102(a).

Applicants respectfully contend that the application is allowable, and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

By: /Baerbel R. Brown, Reg. # 47449/
Baerbel R. Brown, Reg. No. 47,449
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065
Tel: (732)594-0672

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